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R THOMAS PAYNE
CUMMINGS & LOCKWOOD
FOUR STAMFORD PLAZA
P.O. BOX 120
STAMFORD, CT 06902

In re Application of
LINDBO

Application No.: 09/445,843
PCT No.: PCT/SE98/01316
Int. Filing Date: 03 July 1998
Priority Date: 24 July 1997
Attorney's Docket No.: 639321.0004(MIII-102)
For: INTERNET CACHING SYSTEM

:
: DECISION ON
:
: PETITION
:
: UNDER 37 CFR 1.47(b)
:

This is in response to the renewed petition under 37 CFR 1.47(b), filed 16 May 2001 to permit petitioner (applicant) to file the above-captioned application on behalf of the non-signing sole inventor, Sverker LINDBO. Applicant's petition for an extension of time of four months under 37 CFR 1.136(a) is granted. On 22 June 2001, petitioner filed a combined declaration under 37 CFR 1.63 and Oath/Power of attorney executed on behalf of the non-signing inventor by Timo Aittola, Chief Financial Officer of Mirror Image Internet, Inc.

BACKGROUND

On 24 July 2000, petitioner filed a petition requesting that the above-identified application be accepted under the provisions of 37 CFR 1.47(b).

On 16 November 2000, a decision on applicant's petition under 37 CFR 1.47(b) was mailed indicating that applicant failed to provide: (1) factual proof that the inventor refused to execute the application or cannot be reached after diligent effort, (2) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, and (3) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application.

On 16 May 2001, applicants filed a renewed petition under 37 CFR 1.47(b) accompanied by Statements of Facts In Support of Filing on Behalf of Nonsigning Inventor pursuant to 37 CFR 1.47(b) by attorneys R. Thomas Payne, George Chaclas and MaryJo Johnson and by Timo Aittola, Chief Financial Officer of Mirror Image Internet, Inc. As noted above, on 22 June 2001, petitioner filed a combined declaration under 37 CFR 1.63 and Oath/Power of attorney executed on behalf of the non-signing inventor by Mr. Aittola as Chief Financial Officer of Mirror Image Internet, Inc.

On 22 June 2001, a declaration signed by the 37 CFR 1.47(b) applicant was filed. Because the 16 November 2000 decision was ambiguous in requiring the oath /declaration and the 16 May 2001 renewed petition appeared to be a *bona fide* attempt to fully reply to that decision, pursuant to 37 CFR 1.135(c), the submission of the declaration on 22 June 2001 is deemed timely.

DISCUSSION

As previously stated, a petition under 37 CFR 1.47(b) must include (1) the \$130.00 petition

fee, (2) factual proof that the inventor refuses to execute the application, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor(s), (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. In the original petition, applicant satisfied items (1), (3) and (6) but failed to satisfy items (2), (4) and (5) of 37 CFR 1.47(b).

On 22 June 2001, applicant submitted a new declaration signed by Mr. Aittola which meets the requirements of 37 CFR 1.497 and 37 CFR 1.63. Therefore, item (4) now is satisfied.

Concerning item (2), applicant has included declarations by Mr. Aittola, the Chief Financial Officer of Mirror Image Internet, Inc., and from attorneys for applicant, R. Thomas Payne, George Chaclos, and two declarations by Mary Jo Johnson.

In the original petition, applicant failed to show that Mr. Lindbo was presented with a complete copy of the application papers including specification, claims, drawings, and oath or declaration. In her declaration regarding attempts to obtain Mr. Lindbo's signature, Ms. Johnson states that on 09 May 2001, a paralegal delivered to Mr. Lindbo's attorney's "a copy of the application and associated Oath/Declaration under cover letter from T. Thomas Payne, Cummings & Lockwood." (Johnson decl., ¶4)

Mr. Payne confirmed this account in his declaration. (See Payne decl., ¶4). A copy of the application and cover letter, which was hand delivered to Mr. Lindbo's attorney's, was also submitted. Thus, applicant has shown that Mr. Lindbo was presented with a complete copy of the application. (See Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP)).

Further evidence of Mr. Lindbo's refusal to sign the documents are set forth in Mr. Aittola's declaration. Mr. Aittola described the actions which took place after the dismissal of the original petition. Mr. Aittola recounts that settlement discussions "finally broke down around the end of April 2001 when Mr. Lindbo (through his counsel) rejected any use of an escrow, that did not involve an immediate cash payment to Parfi of \$160,000." (Aittola decl., ¶12).

Ms. Johnson states that on 10 May 2001, she contacted Ms. Busny, an attorney for Mr. Lindbo, who told her "that Mr. Lindbo would not sign the relevant documents unless Mirror Image Internet, Inc. paid \$160,000 to Parfi AB." (Johnson decl., ¶5) Ms. Johnson further explains that she informed Ms. Busny that Mirror Image would not pay the \$160,000 and requested that Ms. Busny prevail upon her client to sign the papers. (Johnson decl., ¶6) Finally, Ms. Johnson states that she "has not heard from Ms. Busny since that conversation and has not received any message that Ms. Busny has attempted to reach the undersigned as of the execution of this document."

In his declaration, Mr. Payne also claims that [o]n May 15, 2001, "after placing a telephone call to Elise Busny, one of Mr. Lindbo's attorneys, Elise Busny clearly stated that Mr. Lindbo would not sign the declaration unless Mr. Lindbo were to receive a \$160,000 payment". (Payne decl., ¶5). These declarations are sufficient to show that Mr. Lindbo refuses to execute the declaration. Therefore, item (2) is also satisfied.

As for item (5), petitioner has now provided an English translation of the assignment. The assignment indicates that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant prior to the date the application is deposited in the United States Patent and Trademark Office. A statement under 37 CFR 3.73(b) by the assignee was provided by Timo Aittola.

Accordingly, applicant has met all of the requirements of 37 CFR 1.47(b).


CONCLUSION

Applicant's renewed petition under 37 CFR 1.47(b) is **GRANTED**.

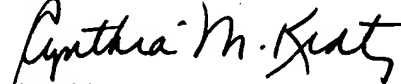
As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the non-signing inventor at the last known address of record as set forth in the papers filed 24 July 2000, and a notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

Applicant has completed the requirements for acceptance under 35 U.S.C. § 371(c). The application has an international filing date of 03 July 1998, under 35 U.S.C. 363, and a 35 U.S.C. 371(c) date of **22 June 2001**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.


Boris Milef
PCT Legal Examiner
PCT Legal Office

CMK/BM:cmk


Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Tel: 703-306-5467
Fax: 703-308-6459



UNITED STATES DEPARTMENT OF COMMERCE
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Patent Cooperation Treaty
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Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

OFFICIAL GAZETTE NOTICE

37 CFR 1.47 Notice by Publication

Notice is hereby given of the filing of a national stage application with a petition under 37 CFR 1.47 requesting acceptance of the application without the signature of all inventors. The petition has been granted. A notice has been sent to the last known address of the non-signing inventor. The inventor whose signature is missing (Sverker Lindbo) may join in the application by promptly filing an appropriate oath or declaration complying with 37 CFR 1.63. The international application number is PCT/SE98/01316 and was filed on 03 July 1998 in the name of Sverker Lindbo for the invention entitled INTERNET CACHING SYSTEM. The national stage application is assigned number 09/445,843 and has a 35 U.S.C. 371(c) date of 22 June 2001.

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WASHINGTON, D.C. 20231
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SVERKER LINDBO
40 ELM STREET
WELLESLEY, MA 02481

In re Application of :
Sverker LINDBO :
Application No.: 09/445,843 :
PCT No.: PCT/SE98/01316 :
Int. Filing Date: 03 July 1998 :
Priority Date: 24 July 1997 :
Attorney's Docket No.: 639321.0004(MIII-102) :
For: INTERNET CACHING SYSTEM :

Dear Mr. Lindbo:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(b) and 35 U.S.C. § 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Boris Milef
Legal Examiner
PCT Legal Office

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office
Telephone (703) 306-5467

R. Thomas Payne
CUMMINGS & LOCKWOOD
Four Stamford Plaza
P.O. Box 120
Stamford, CT 06902

Professional Corporations

CUMMINGS & LOCKWOOD

Four Stamford Plaza
P.O. Box 120
Stamford, CT 06904-0120
203.327.1700
Fax 203.351.4535
www.cl-law.com

Stamford
Hartford
Greenwich
New Haven
West Hartford
Naples
Palm Beach
Bonita Springs

TRANSMIT THE ATTACHED TO

Date: June 22, 2001

Name: Cynthia Kratz
Company: USPTO
Fax: (703) 308-6459
Confirming No.:

Name:
Company:
Fax:
Confirming No.:

Name:
Company:
Fax:
Confirming No.:

Name:
Company:
Fax:
Confirming No.:

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22 JUN 2001

Legal Staff
International Division

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From: George Chaclos
Phone: 203-351-4103
Email: gchaclo@cl-law.com
Personal Fax:

Client No.: 639321.0004
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